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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/708,129	11/07/2000	David N. Spiegel	END920000101US1	1094

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EXAMINER
RUTTEN, JAMES D

ART UNIT	PAPER NUMBER
2122	

DATE MAILED: 12/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>05 August 2004</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-18</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-18</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage

        application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.
5)☐ Notice of Informal Patent Application (PTO-152)
6)☐ Other: _____.

DETAILED ACTION

1.   Acknowledgement is made of Applicant's amendment dated August 5, 2004, responding

to the May 5, 2004 Office Action provided in the rejection of claims 1-18, wherein claims 1, 9,

17 and 18 have been amended, no claims have been canceled, and no new claims have been

added. Claims 1-18 remain pending in the application and have been fully considered by the

examiner.

2.   Applicant has primarily argued on pages 11-16 of the response dated August 5, 2004, that

the claims are not anticipated by Stupek because it does not disclose numerous claim limitations.

This argument is not persuasive, as will be addressed under the *Response to Arguments* section

below.

3.   Applicant's amendment necessitated the new ground(s) of rejection presented in this

Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this

final action.

Response to Arguments

4.   Applicant's arguments filed 8/5/2004 have been fully considered but they are not

persuasive.

5.   Applicant argues on page 12 that Stupek fails to disclose a database of known second

maintenance items. In support of this, Applicant alleges that Stupek's upgrade database entries

are limited to data regarding an upgrade package which resides upon a CD-ROM, and that the

items are provided concurrently with the maintenance items. The examiner disagrees. Stupek

describes distribution of upgrades not only from a portable storage medium such as a CD-ROM,

but also from an online server (column 2 lines 44-46). Further, Stupek also describes storing

upgrade information regarding packages that are not concurrently provided with the upgrade

database (column 7 lines 19-35). While it is agreed that Stupek's known second maintenance

items are dependant upon the particular upgrade package that is currently being installed

(amendment – top of page 13), this limitation is not present in the specific language of the

claims. Therefore, Stupek discloses prerequisite items and corequisite items that are not

provided concurrently with said known second maintenance items, or are limited to residing on a

CD-ROM.

6.   Applicant argues on pages 13 and 14, that Stupek does not search the database of known

second maintenance items. Specifically, the Applicant asserts that Stupek "does not specifically

search the upgrade database with the express purpose of finding records having prerequisite

items and corequisite items". Applicant finds support in a section of Stupek that describes two

conditions for accessing the upgrade database that generally limit Stupek to conditions of

performing a specific package upgrade.   It would appear that the Applicant is arguing that since

Stupek only searches for dependencies in the isolated occurrence of a package upgrade, and does

not provide for a search of known second maintenance items in the absence of an associated

package, then a search for "known second maintenance items" could not occur. The examiner

contends that the language of the claims does not place a condition of when a search for

maintenance items can or cannot occur. Further, the language of claim 1 also includes,

"searching said database of known second maintenance items for records matching each of said

new third maintenance items…". This appears to clash with the Applicant's argument, since a

search is only conducted in the presence of the third list. Such a scenario is precisely what

Stupek provides when a search is only conducted in the presence of an upgrade. As such, a

search for known second maintenance items occurs, as Stupek points out in column 7 lines 6-35.

7.   Applicant argues at the bottom of page 14 that Stupek does not include adding said

corresponding prerequisite items and corequisite items to said first list. However, Stupek

discloses the addition of prerequisite and corequisite items to the first list. After the list of

available upgrades is created by the upgrade advisor (column 3 line 57 – column 4 line 5), the

package database is searched for pre/co-requisites and the available pre/co-requisites are added

to the initial list of upgrades (column 7 lines 29-33). An upgrade cannot be installed if an

associated pre/co-requisite is not available, and Stupek discusses pre/co-requisites in the context

of automatic installation (column 7 lines 6-10). In response to applicant's argument that Stupek's

method of displaying the list is not equivalent to Applicant's adding step (1st paragraph on page

15 of Applicant's response), a recitation of the intended use of the claimed invention must result

in a structural difference between the claimed invention and the prior art in order to patentably

distinguish the claimed invention from the prior art. If the prior art structure is capable of

performing the intended use, then it meets the claim. In a claim drawn to a process of making,

the intended use must result in a manipulative difference as compared to the prior art. See *In re*

Casey, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

8.   Applicant argues on pages 15 through 16 that Stupek does not teach or suggest ordering,

receiving, and applying said items on said order list. Applicant further develops this argument

on page 16 to assert that Stupek does not order, receive, and apply an item that was not originally

included with the new maintenance items. While the examiner agrees with this last argument,

the specific language of the claim does not feature this limitation. As the examiner has a duty to

broadly interpret the claim, the steps of ordering, receiving, and applying are made in the context

of readily available maintenance items. Furthermore, discussion of ordering, receiving and

applying maintenance items in the originally filed specification on page 9 line 24 – page 10 line

4 merely mentions these steps and does not particularly describe a process for ordering.

Claim Rejections - 35 USC § 112

9.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making
> and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it
> pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode
> contemplated by the inventor of carrying out his invention.

10.   Claims 1-18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with

the written description requirement. The claim(s) contains subject matter which was not

described in the specification in such a way as to reasonably convey to one skilled in the relevant

art that the inventor(s), at the time the application was filed, had possession of the claimed

invention. Claim 1 recites "a database of known second maintenance items including

prerequisite items and corequisite items corresponding to each of said known second

maintenance items **but not provided concurrently with said known second maintenance**

items" (emphasis added). This limitation is not supported by the specification. Description of

the database application and of the list of second maintenance items is found on page 8 lines 13-

22 and page 9 lines 6-13 of the originally filed specification. No indication that the prerequisite

and corequisite items are not provided concurrently with said known second maintenance items

can be found.

      Claims 9, 17, and 18 suffer the same deficiencies as claim 1.

      Claims 2-8, and 10-16 are rejected as being dependent upon a rejected base claim.

Claim Rejections - 35 USC § 102

11.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12.   Claims 1, 3-9, and 11-18 are rejected under 35 U.S.C. 102(b) as being anticipated by

prior art of record U.S. Patent No. 5,960,189 to Stupek et al.

      As per claim 1, Stupek discloses:

A method of maintaining software on a computer system (See Abstract)

comprising the steps of:

Bringing up first and second host sessions on a computer system (FIG. 1 elements

1 and 2);

Starting in said first host session, a software recording application having data

on existing first maintenance items that have been previously applied to said computer

system (figure 1 reference 5 "Management Information Base", column 3 lines 22-30, "A

management information base (MIB) within the server

maintains basic descriptive information about each of the

resources **available** on the server." Resources that are currently

available and exist on the server, inherently must have been previously applied, otherwise

they would not be available.);

Starting in said second host session, a database application having a database of

known second maintenance items including prerequisite items and corequisite items

corresponding to each of said known second maintenance items (figure 1 reference 9

"Upgrade Database", column 3 lines 44-column 7 lines 8-10, "The database also

contains information regarding the dependencies between the

package and other upgrade objects or packages…" Maintenance

items must inherently be known if information regarding them is stored in a database. As

a database is a collection of knowledge, it would not exist without knowledge of its

members.);

Activating a maintenance application on said computer system (figure 1 reference

11 "Upgrade Advisor");

Entering a first list of new third maintenance items in said maintenance

application (figure 1 reference 7 "Resource Upgrades", column 3 lines 31-43,

"**Upgrades** to the network resources are provided to a server

manager by a distribution medium (not shown), such as a CD-

ROM. The upgrades 7 may also be provided by an on-line

service (not shown), such as a bulletin board service

administered by a manufacturer of network resources." Upgrades

inherently provide a new version of a product, otherwise they might be called a

"downgrade", or "rollback". Also see column 3 line 57 – column 4 line 5.);

Searching said database of known second maintenance items for records

matching each of said new third maintenance items that have said prerequisite items and

corequisite items, and adding said corresponding prerequisite items and corequisite

items to said first list (column 4 lines 20-27: "The upgrade advisor then

retrieves upgrade information from the upgrade database and

performs two types of comparisons: a) whether or not a

particular upgrade package corresponds to a resource on the

server, and b) whether or not the version number of the

upgrade package matches the version number of the

corresponding network resource (i.e, whether or not the

upgrade package represents a true upgrade for the existing

network resource) ."; also column 7 lines 6-35, especially lines 29-33:

"Therefore, the dependency information in the Package

database 25 describes not only the dependencies between

packages on the CD, but also all dependencies between an

upgrade package and any upgrade not available on the CD.";

also column 4 lines 6-9: "When the analysis is complete, the **upgrade**

advisor 11 presents a report and/or graphical display to

the user. This output is in the form of **upgrade**

recommendations, each supported by an explanation of the

reasons for upgrade." Comment: The first list is analyzed by the upgrade

advisor and modified according to the current maintenance needs, including a report, or

list, of prerequisites and corequisites.);

    Thereafter determining from said software recording application which items on

said first list have already been received, and adding those items not received to an order

list (column 4 lines 20-27 as cited above describes the determination of items that have

already been received; also column 4 lines 45-48: "When the upgrade advisor

11 and/or the user have **selected 100 the network resources**

3 that need to be upgraded, an upgrade installer 17

oversees the automatic installation of the packages to the

server." Comment: A determination of which items have already been received is

inherent in the selection of "network resources that need to be upgraded". If a resource

does not need to be upgraded, then it must have already been received. Selection of

resources is impossible without determination. ; also column 5 lines 41-45: "In the

server upgrader 22, several upgrade packages 7 and the

corresponding installation instructions 20 are **grouped 108**

into a "job" 18. Within each job 18, the installation

instructions for every package are included in a control

file 18a." Comment: Grouping packages into a job is considered adding to an order

list.); *and*

Ordering, receiving, and applying said items on said order list (column 4 lines

45-48 as cited above in addition to column 4 lines 48-53: "At the outset, the

appropriate upgrade packages 7 are **retrieved** 102 from the

distribution medium (or the on-line service) and **supplied**

106 to a server upgrader 22 located in the upgrade

installer 17. Installation instructions 20 are retrieved

104 from the database 9 and are supplied 106 to the server

upgrader 22."; also column 5 lines 48-63, "When the job is ready to be

installed to the target server, the server upgrader

connects with the server...and then sends the job...to a

staging area. The staging area may...be anywhere else in the

network capable of handling the deposit and retrieval of

upgrade files....the agent executes the instructions in the

control file...").

As per claim 3, the above rejection of claim 1 is incorporated. Stupek further discloses the use of an operating system with the computer system (column 1 line 17).

As per claim 4, the above rejection of claim 3 is incorporated. Stupek further discloses the use of a network with the computer system (column 1 line 13).

As per claim 5, the above rejection of claim 1 is incorporated. Stupek further discloses the practice of keeping track of what software has been installed or uninstalled (column 6 lines 45-47).

As per claim 6, the above rejection of claim 1 is incorporated. Stupek further disclose the use of a database application through the use of the "server database" (column 4 lines 14-16).

As per claim 7, the above rejection of claim 1 is incorporated. Stupek further discloses the practice of storing information relating to program updates in a file (column 6 lines 43-45).

As per claim 8, the above rejection of claim 1 is incorporated. Stupek further discloses the practice of updating software on the computer system (column 5 lines 48-63).

As per claim 9, Stupek discloses:

A system for maintaining software on a computer system (FIG. 1) *comprising:*

a maintenance application having a first list of third maintenance items wherein

the first list comprises a list of maintenance items needed to be applied to said computer

system (figure 1 reference 11 "Upgrade Advisor"; figure 1 reference 7 "Resource

Upgrades", column 3 lines 31-43, "Upgrades to the network resources

are provided to a server manager by a distribution medium…";

also column 3 line 57 – column 4 line 7: "When the upgrades 7 become

available to the network (e.g., by inserting the CD-ROM

into the server manager drive, or by logging into the on-

line service), an upgrade advisor 11 in the upgrade device

10 automatically analyzes each network resource 3 currently

on the server 1 to determine the availability and **necessity**

of the corresponding upgrade 7. When the analysis is

complete, **the upgrade advisor 11 presents a report** and/or

graphical display to the user.");

All other limitations have been addressed in the above rejection of claim 1.

As per claims 11-16, the above rejection of claim 9 is incorporated. All further

limitations have been addressed in the above rejections of claims 3-8, respectively.

As per claim 17, all limitations have been addressed in the above rejections of

claims 1 and 9.

As per claim 18, Stupek discloses a computer program product (column 3 lines

31-33). Stupek further discloses a computer readable medium and program instruction

means (column 11 line 9 – column 14 line 33). All further limitations have been

addressed in the above rejection of claim 1.

Claim Rejections - 35 USC § 103

13.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

14.   Claims 2 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stupek et

al as applied to claims 1 and 9, respectively, above, and further in view of "Y2K Compliance and

the Distributed Enterprise" by Gowan et al.

As per claim 2, Stupek does not expressly disclose software maintenance on a

mainframe.

However, in an analogous environment, Gowan et al. teaches the benefits of

upgrading a mainframe computer system (page 68, paragraph 1).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Stupek's software maintenance system with Gowan's concept of upgrading a mainframe computer in order to facilitate a swift and automated upgrade process. This is desirable since mainframe computers serve a large number of users, and having a swift and automated upgrade process ensures the availability of correct and efficient software.

As per claim 10, all further limitations have been addressed in the above rejection of claim 2.
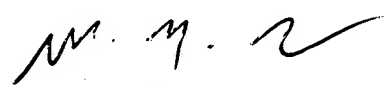
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Derek Rutten whose telephone number is (571) 272-3703. The examiner can normally be reached on M-F 6:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Q. Dam can be reached on (571) 272-3695. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

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system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

WEI Y. ZHEN
PRIMARY EXAMINER

jdr